

REMARKS

Changes to the Specification:

The specification has been amended to correct some grammatical and typographical errors. Also, on page 11, line 15, the word previously omitted word "game" has been added after the word "bonus". Since the term "bonus game" is used extensively throughout applicant's specification, this amendment is fully supported by applicant's disclosure. No new matter has been added.

Changes to the Claims:

Claims 1-16 have been amended to correct typographical errors and to more clearly define the scope of the claimed invention. No new matter has been added.

Changes to the Drawings:

The applicant proposes amending FIGS 1 and 2 to include reference numeral 17 designating the various indicia in these two figures. Support for this addition to the drawings may be found in applicant's specification on page 10, lines 12 – 20. No new matter has been added.

Rejection under 35 U.S.C. § 103(a):

Claims 1, 6, 8, and 10-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Thomas et al. (U.S. Patent No. 6,190,255 hereafter Thomas) in view of Walker et al. (U.S. Patent No. 6,293,866 hereafter Walker).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criterion above, Applicant asserts that the first and third criteria of the prima facie case of obviousness are not satisfied.

The Proffered Combination of Prior Art Does Not Teach All the Limitations of the Independent Claims:

Claim 1 defines the limitations: depicting to the player, before play of the base game, information about a plurality of aspects for playing the bonus game; allowing the player to pre-select one of the plurality of aspects for playing the bonus game before play of the base game; and basing the play of the bonus game upon the pre-selected aspect of the bonus game so that the playing of the bonus game is customized by the player in accord with the pre-selected aspect. Claim 11 defines the limitations: depicting to the player information about a plurality of aspects for playing the bonus game; allowing the player to pre-select one of the plurality of aspects for playing the bonus game; and basing the play of the bonus game upon the pre-selected aspect of the bonus game so that the playing of the bonus game is customized by the player in accord with the pre-selected aspect.

Thomas does not teach or suggest these limitations. The examiner admits, on page 3 of the instant office action, that "Thomas lacks in disclosing to the player, before, upon, or during play of the base game, information about a plurality of aspects for playing a bonus game, allowing the player to pre-select one of the plurality of aspects for playing the bonus game before, upon, or during play of the base game, and basing the play. . . . customized by the player in accord with the pre-selected aspect. Moreover, Applicant asserts that Walker does not cure this deficiency.

The office action implies that Walker cures the deficiencies in the teachings of Thomas. Applicant has reviewed the Walker disclosure, particularly the portions cited in the office action, and cannot find any teaching or suggestion of allowing a player to pre-select aspects of a bonus game or of the other limitations of claims 1 or 11. Accordingly, Applicant respectfully contends that the proffered combination of Thomas and Walker does not teach all the limitations of claims 1 and 11 and that the third criterion of the prima facie case of obviousness is not satisfied for these claims.

There is Insufficient Motivation to Combine or Modify the References:

Applicant contends that there is insufficient motivation to combine the references. The mere fact that references can be combined or modified does not render the resultant

combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01; *In re Mills*, 916 F.2d 680, 16 USPQ 1430 (Fed. Cir. 1990).

The examiner contends that the motivation to combine is to improve the psychological approach gaming players have towards games of chance by providing players with a sense of comfort and to enhance a player's bonus game experience. This motivation has been supplied by the office action and not by the prior art, which is improper. Accordingly, applicant asserts that the first criterion of the prima facie case of obviousness under M.P.E.P. § 2143 is not satisfied for claims 1 and 11.

Since the first and third criteria of the prima facie case of obviousness are not satisfied for claims 1 and 11, applicant asserts that claims 1 and 11 are patentable over Thomas in view of Walker under 35 U.S.C. § 103(a). Claims 6, 8, and 10 depend on claim 1 and claims 12-13 depend on claim 11, and the dependent claims inherit all the limitations of their respective independent claims. Accordingly, claims 6, 8, 10, and 12-13 are also patentable over Thomas in view of Walker.

Rejection under 35 U.S.C. § 103(a):

Claims 2-7, 9, and 14-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Thomas in view of Walker, further in view of the Trivial Pursuit Millennium Edition (hereafter TPME). Applicant has already shown that claims 1 and 11 define limitations not taught by the combination of Thomas and Walker. Claims 2-7 and 9 depend on claim 1, claims 14-16 depend on claim 11, and the dependent claims inherit all the limitations of their respective independent claims. Accordingly, claims 2-7, 9, and 14-16 also define limitations not taught by the combination of Walker and Thomas. Moreover, the TPME is not relied upon to cure this deficiency. Accordingly, claims 2-7, 9, and 14-16 are patentable over Thomas in view of Walker, further in view of the TPME.

In view of the foregoing, Applicant contends that all claims are allowable and respectfully requests that the instant application be passed to issue. Should there be any questions regarding this matter, the examiner is requested to call the below-listed attorney. A check has been submitted to cover fees due in connection with filing. However, if additional fees are required, please debit our Deposit Account No. 04-1414.